

REMARKS

Amended claim 8 and new claims 9-11 are pending. Reconsideration in view of the above amendments and the following remarks is respectfully requested.

Rejection under 35 U.S.C. § 112, first paragraph

In the Office Action, claim 8 is rejected under 35 U.S.C. § 112, first paragraph, based upon the alleged lack of an enabling disclosure. However, it is clear based on the disclosure in the application that one of ordinary skill in the art would have known what structure, materials or acts perform the functions recited in claim 8 as well as new claim 9. In particular, one of ordinary skill in the art would have known the structure, materials or acts for performing the function of identifying characteristics of stroke in an acute phase defined in claim 8. Similarly, one of ordinary skill in the art would have known the structure, materials or acts for the instruction means defined in claim 9. Stated differently, the structure corresponding to the means-plus-function limitation is implicit in the written description since it is clear to those skilled in the art which structure can perform the claimed functions. See MPEP 2181. In fact with regard to claim 8, the Examiner has identified US. Patent No. 5,305,745 by Zacouto, for its teaching of identifying an apparatus relating to diagnosing stroke. Accordingly, withdrawal of the rejection is respectfully requested.

Rejection under 35 U.S.C. § 112, second paragraph

Claim 8 was rejected under 35 U.S.C. § 112, second paragraph. By this Amendment, claim 8 has been amended to address the concerns raised by the Examiner. Withdrawal of the rejection is respectfully requested.

Rejection under 35 U.S.C. § 102(e)

Claim 8 was rejected under 35 U.S.C. § 103(a) over Remmers et al. in view of Zacouto (U.S. Patent No. 5,305,745). Applicant respectfully requests that the Examiner withdraw the rejection.

First, Applicants respectfully submit that claim 8 sets forth an apparatus for carrying out the inventive method which is already patented by the same Examiner in claim 1 of U.S. Patent No. 6,336,454. Thus, it is improper for the Examiner to reject claim 8 since claim 8 is an analog of the method claim already found patentable by the Examiner in the parent patent. Stated differently, claim 8 is the linking claim under MPEP 806.05(e) and therefore cannot be rejected

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Second, as the Examiner is aware, the initial burden of demonstrating a *prima facie* case of obviousness is on the Examiner. *In re Rinehart*, 531 F.2d 1048, 189 U.S.P.Q. 143 (C.C.P.A. 1976). A *prima facie* case requires, *inter alia*, a showing of all of the elements of the claims in the prior art and some suggestion or motivation to modify or combine the references based upon the prior art or a general knowledge in the field, *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998); See MPEP § 2143. The simple fact that an apparatus is capable of being modified to perform a claimed feature is insufficient as a basis for a nonobvious rejection without some suggestion to do so. *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430 (Fed. Cir. 1990). It is long settled that:

The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims ... is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of the [Applicant's] specification, to make the necessary changes in the reference device.

Ex parte Chicago Rawhide Mfg Co., 223 USPQ 351, 353 (BdPatApp&Int 1984). The teaching or suggestion cannot be taken from the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In the current rejection, the Examiner's "suggestion to modify" does not have any basis in the prior art. The combination is nothing but impermissible hindsight based on Applicants' disclosure which is the only disclosure that teaches the use of a CPAP type device during stroke. This type of obviousness rejection is improper. As such, no *prima facie* case of obviousness has been made. Applicants discovered the useful benefits for combining positive airway pressure in accordance with means for identifying characteristics of stroke in a patient. Accordingly, withdrawal of the rejection is respectfully requested.

Obvious Type Double Patenting

Claim 8 was rejected under the judicially created doctrine of obviousness type double patenting over claims 1-4 of U.S. Patent No. 6,336,454. The Examiner has not set forth a *prima facie* case' for rejecting these claims based on the obviousness-type double patenting because the elements of the claims of the patent have not been compared to the elements of the claims of the present case. Nevertheless, Applicant's traverse this rejection for the reason that it is premature to file a Terminal Disclaimer at this point as the claims have not been indicated to be

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otherwise allowable. If the Examiner indicates these claims to be allowable, Applicants will reconsider the filing of a Terminal Disclaimer to expedite prosecution.

In view of the above amendments and remarks, Applicants respectfully submit that the application is in condition for allowance. The application as amended claims novel and non-obvious subject matter. Should the Examiner believe that anything further is desirable to expedite allowance of the application, he is invited to contact the undersigned at the telephone number listed below. Early and favorable allowance is requested.

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